

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 37202/102001; 990006US1	
	Application Number 09/900,485-Conf. #4159	Filed July 6, 2001	
	First Named Inventor Rod A. Cherkas et al.		
	Art Unit 3691	Examiner S. E. Chencinski	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>46,479</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 35%; text-align: center;"> <p>_____ /Robert P. Lord/ Signature</p> <p>_____ Robert P. Lord Typed or printed name</p> <p>_____ (713) 228-8600 Telephone number</p> <p>_____ February 15, 2008 Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.			

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Rod A. Cherkas et al.

Confirmation No.: 4159

Application No.: 09/900,485

Art Unit: 3691

Filed: July 6, 2001

Examiner: S. E. Chencinski

For: AUTOMATED, USER SPECIFIC TAX
ANALYSIS OF INVESTMENT
TRANSACTIONS USING A PERSONAL TAX
PROFILE

MS AF
Commissioner for Patents
P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-26 are pending. Claims 1, 19, 20, 22, and 24 are independent. The remaining claims depend, directly or indirectly, from claims 1, 20, 22, and 24. The claims were finally rejected in the Office Action dated November 30, 2007 ("Final OA").

Rejections under 35 U.S.C. § 103

Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable U.S. Patent No. 6,161,098 ("Wallman"). "Obviousness [under 35 U.S.C. § 103] is a question of law based on underlying factual inquiries." MPEP § 2141. Specific factual inquiries for determining obviousness were laid out in *Graham v. John Deere Co. (Graham)*, 383 U.S. 1, 148 USPQ 459 (1966), and reiterated by the Supreme Court in *KSR International Co. v. Tele-flex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007). The factual inquiries include: (i) Determining the scope and content of the prior art; (ii) Ascertaining the differences between the claimed invention and the prior art; and (iii) Resolving the level of ordinary skill in the pertinent art. "The question of obviousness must be resolved on the basis of these factual determinations. While each case is

different and must be decided on its own facts, the *Graham* factors, including secondary considerations when present, are the controlling inquiries in any obviousness analysis.” MPEP § 2141.

In addition, a proper reading of the claim depends on giving the words in the claims their *ordinary and customary meaning*, which is the meaning that the words would have to a *person of ordinary skill in the art* in question as of the effective filing date of the patent application. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (*en banc*); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (emphasis added). In particular, “[t]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but *in the context of the entire patent, including the specification*.” *Phillips*, 415 F.3d 1303 at 1313 (Fed. Cir. 2005) (*en banc*) (emphasis added). Applicants respectfully assert that the Examiner has not factually supported a *prima facie* conclusion of obviousness for the claims.

1. **The Examiner is mischaracterizing Wallman to teach or suggest “wherein the potential total future tax liability of the user is computed using the actual and forecasted tax data and the tax return information” from the user tax profile that is particularized to the user.**

Independent claim 1 recites, in part, “wherein the tax profile combines and stores actual and forecasted tax data *particularized to the user*” [Emphasis added]. Further, independent claim 1 requires that this particularized information be used to compute the “total future tax liability of the user” for a potential investment transaction. Because embodiments of the present invention combine tax data from a variety of sources and store such tax data in the user tax profile in accessible form, embodiments of the invention provide a unique database of information specific to a user that was previously difficult to gather, maintain, and quickly recall.

The Examiner contends that, by definition, a tax return is confined to one tax year, so tax information is inherently related to each separate year. *See* Final OA, page 2. Applicant respectfully disagrees. By combining tax return information as well as actual and forecasted tax data for a particular user, the information gathered for the specific user is not limited to discrete years. In fact, the robust variety of information gathered for a specific user allows for the prediction of trends in user tax data and forecasting of future tax liability of the user. This combination of information in one database in accessible form is precisely what Wallman lacks.

The Examiner contends that Wallman teaches determining consequences of an investment transaction to a potential total tax liability of a user. The Examiner further contends that Wallman teaches storing a tax profile containing tax return data for at least one tax year of the user, and states that the stored tax profile containing the tax return data is *inherent* (*see* Final OA, page 3). Applicants respectfully assert the Examiner's inherency argument is flawed for the following reasons.

To support a rejection based on inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP § 2112 (citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Wallman simply teaches computing a tax liability for a *particular transaction or series of transactions* (i.e., selling of stocks/bonds/assets/liabilities). *See* Wallman, col. 3, ll. 35-37. Wallman clearly states "determining the potential tax consequences that would result from trading various combinations of the plurality of assets/liabilities, in which each of the potential tax consequences represents the potential tax consequence that would result from trading one particular subset of assets/liabilities." Thus, Wallman is focused only on tax consequences resulting from a *particular sale* of one or more securities. Wallman is only concerned with this

particular sale, so Applicants assert that storing tax data unrelated to this particular transaction (e.g., actual and forecasted tax data particularized to a user) in a tax profile is not necessary. In fact, Wallman is completely silent with respect to, and therefore cannot teach or suggest, storing actual and forecasted tax data particularized to a user in accessible form in a tax profile associated with the user. Thus, such a tax profile is not *necessary* from the teachings of Wallman, so such a claim of inherency is improper.

Further, the combining and storing of such robust tax data *in an accessible form* is not something that can be characterized as inherent, because tax professionals view this as something that is lacking in current tax products/software. The Examiner's contention that Wallman teaches a tax profile as required by the claimed invention would require mischaracterizing the teachings of Wallman and/or alter the primary mode of operation taught by Wallman to a procedure not even contemplated by Wallman, both of which are improper. *See*, MPEP §2143.03.

More importantly, Wallman does not gather, combine, and store tax data for multiple previous tax years for a particular user, such that a total future tax liability can be calculated *on the spot* for a user based on a proposed transaction or an actual completed transaction. Rather, Wallman only uses information related to the sale of assets/liabilities to compute tax consequences associated with *that particular sale*. Said another way, Wallman is focused on using information from a single securities transaction to compute tax liability as it relates solely to that transaction, and not tax information associated with a *user's overall tax scenario*. In fact, the Examiner admits that Wallman lacks the teaching of computing a total future tax liability. *See* Final OA, bottom of page 3. The cited portion of Wallman merely discloses the use of information stored in tax programs to compare such tax program information to capital assets stored in the database to identify potential tax savings from engaging in *a transaction* involving

the capital assets. *See* Wallman, col. 6, ll. 6-12. More importantly, Wallman also fails to teach or suggest using the information stored in the tax programs to compute a user's potential total future tax liability, as required by the pending independent claims. At best, Wallman arguably teaches that the tax program information is used to compute the tax consequences associated directly and solely with *the particular transaction(s)* involving the capital assets without taking into account the overall tax liability of the user (*i.e.*, whether the taxpayer receives a refund, is disqualified from taking a deduction or tax credit, triggers the alternative minimum tax (AMT) resulting in the payment of additional taxes when filing the future tax return).

Thus, because Wallman does not consider the robust amount of tax data claimed in the present invention in computing tax liability of a user, Wallman fails to teach the recited independent claims.

2. The Examiner has not satisfied the requirements of MPEP § 2143.

In view of the above, the Examiner has failed to satisfy the requirements of MPEP § 2143. Specifically, Wallman fails to teach or suggest all of the limitations of independent claims 1, 19, 20, 22, and 24. Dependent claims 2-18, 21, 23, and 25-26 are allowable for at least the same reasons. Accordingly, a favorable decision from the panel is respectfully requested. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 37202/102001).

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Respectfully submitted,

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